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3622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/879,825	Applicant(s) BARNETT ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 4/13/05 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

Please see the letter from the Board of Appeals dated 11/4/05.

Arthur Duran



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 6/15/05

Application Number: 09/879,825

Filing Date: June 12, 2001

Appellant(s): Craig W. BARNETT et al.

Bradford C. Blaise
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/13/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The Appellant's statement of the Grounds of Rejection to be Reviewed on Appeal in the brief is correct.

(7) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

5,227,874	Von Kohorn	7-1993
5,734,823	Saigh	3-1998
4,882,675	Nichtberger	11-1989
5,380,991	Valencia	01-1995
5,592,378	Cameron	01-1997

(9) Grounds of Rejection***Claim Rejections - 35 USC § 112***

Claim 52, 58 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 52 discloses a TCP/IP network. However, nowhere in applicants specification is a TCP/IP network explicitly disclosed.

Additionally, the claim is broader in scope than the specification. A TCP/IP network is broader than the Internet. Because TCP/IP is a protocol, there are TCP/IP based networks which are not part of the Internet. Hence, a TCP/IP network is broader than the Internet which is one manifestation of a TCP/IP network.

Claim 58 discloses, 'according to claim 57 wherein prior to step A, the server receives a request for information from the client'. However, the Applicant's Specification does not disclose the server receiving a request for information from the client prior to establishing a connection over a communications channel between a client and a server.

Claim Rejections - 35 USC § 103

Claims 47-51 and 53-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger (4,882,675) in view of Valencia (5,380,991).

Claims 47, 57: Nichtberger discloses a system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a client system, said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel (col 5, lines 1-16; col 11, lines 40-50; col 30, lines 1-6);

said client system including associated memory, said client system being adapted for storing said electronic coupon in said memory (col 30, lines 1-6);

a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon (col 30, lines 1-6).

Nichtberger further discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

Also, Nichtberger (col 30, lines 1-6) and Valencia (col 7, lines 41-49) disclose that the client system stores electronic coupon in said memory.

Additionally, in Nichtberger (col 30, lines 1-6) it is implied that the coupon information in the first server system is transmitted to the client system, which is the card. That the coupon information is transmitted is implied because the coupon information is stored electronically on both the first server system and the client system. And, the information is 'recorded' on the second client system. Hence, the information must be transmitted in order to be recorded in a device where the information had not been.

Also, Nichtberger discloses that there are multiple server systems that interact with the client system for coupon distribution and redemption (Fig. 1, item 10; Col 4, lines 41-47).

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Hence, the user utilizing the client system can be transmitted coupons at one location by a first server system and redeem coupons at a different location by a second or different server system.

In regards to the combination of Nichtberger and Valencia, Nichtberger discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

Claim 48, 59: Nichtberger and Valencia disclose a system according to claim 47, 57, Nichtberger further discloses:

a third server system connected to said communications channel, said third server system being adapted for communicating with said second server system and for authorizing the redemption of said electronic coupon (Fig. 4; col 17, lines 49-60).

Claim 49: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon as

a function of a transaction initiated between said client system and said second server system (Fig. 4).

Claim 50: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon by modifying a transaction initiated between said client system and said second server system (Fig. 4).

Claim 51: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said communications channel includes a network (Fig. 1; col. 15, lines 25-30; col 12, lines 8-15).

Claim 53: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said first server system and said second server system are the same server system (col 5, lines 1-5).

Claim 54: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said electronic coupon is a token issued under the authority of an issuer for the benefit of said client (col 30, lines 17-30).

Claim 55: Nichtberger and Valencia disclose the system according to claim 47, and Nichtberger further discloses that said electronic coupon includes data representative of one or more of a serial or identification number, a validation key, an authentication key, an authorizing vendor, a redeeming vendor, a benefit or discount to be associated with a transaction, a level of access granted, and an issuing activity (col 30, lines 17-30; col 19, lines 34-39; col 22, lines 1-9).

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Claim 56: Nichtberger and Valencia disclose the system according to claim 47, and Nichtberger further discloses that said electronic coupon includes data representative of the identity of a location at which additional coupon information resides (col 30, lines 24-30).

Claim 58: Nichtberger and Valencia disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Nichtberger further discloses that prior to step A, the server receives a request for information from the client (col 5, lines 3-8; col 10, line 65-col 11, line 5).

Claim 60: Nichtberger and Valencia disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Nichtberger further discloses the steps of establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon (Fig. 4; col 17, lines 49-60; col 11, lines 40-45).

Claim 52, 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger (4,882,675) in view of Valencia (5,380,991) and in further view of Cameron (5,592,378).

Claim 52, 63: Nichtberger and Valencia disclose a system according to claim 47. Nichtberger further discloses that the coupon includes a data component (col 19, lines 34-39; col 22, lines 1-9), that the communications channel operates over a network which can be expansive and operate over remote areas (col 32, lines 1-8; Fig. 1; col 15, lines 25-30; col 12, lines 8-15).

Nichtberger does not explicitly disclose that the network is TCP/IP based.

However, Cameron discloses redeeming coupons over a network that operated over remote areas that utilizes a TCP/IP based network (col 5, lines 13-16; col 11, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cameron's TCP/IP based network to Nichtberger's network operating over a remote area. One would have been motivated to do this because TCP/IP is a standard and effective protocol for a network operating over remote areas.

Furthermore, the Internet is one obvious manifestation of a TCP/IP network. One would have been motivated to utilize the Internet in order to utilize a readily available network.

Claims 47-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,227,874) in view of Saigh (5,734,823).

Claims 47, 52, 53, 57, 61, 62, 63: Von Kohorn discloses a system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a remote client system, said first server system being adapted for transmitting an electronic coupon to said remote client system over said communications channel (col 74, lines 33-40; col 16, lines 30-40; col 19, lines 20-39; Fig. 29, item 904; col 94, lines 35-41; col 95, lines 5-10; col 32, lines 47-55; col 45, lines 41-44); said remote client system including a computer processor and associated memory, said remote client system being adapted for storing said electronic coupon in said memory (Fig. 30; col 14, lines 20-25; Fig. 26; Fig. 27; Fig. 4);

a second server system connected to said communications channel, said second server system being adapted to establish a connection with said remote client system (col 88, lines 29-55) and for detecting said electronic coupon stored on said remote client system (col 3, lines 3-22), said second server system further being adapted to redeem said coupon (col 87, lines 55-66).

Von Kohorn explicitly discloses redemption information transferred electronically (col 40, lines 10-15).

Von Kohorn does not explicitly disclose that the electronic coupon is electronically redeemed by the central station.

However, Von Kohorn further discloses electronic communication and electronic communication between a client and server system (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15; col 88, lines 29-55).

Von Kohorn further discloses redeeming incentives and mailing incentives for redemption (col 8, lines 47-49), redeeming incentives in a variety of manners including over the phone (col 82, lines 40-45; col 87, lines 55-66).

Von Kohorn further discloses that the operator of the service can redeem incentives (col 71, lines 17-23).

Von Kohorn further discloses that tokens can be coupons (col 2, lines 48-53; col 8, lines 44-49).

Von Kohorn further discloses that the first server system and second server system can be part of the same server system (Fig. 31; col 89, lines 37-42).

Von Kohorn further discloses the electronic transfer of incentive information to redemption centers for redemption (col 40, lines 10-15).

Hence, Von Kohorn discloses that either a second, different server system or a second server system associated with the first server system can electronically redeem incentives.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information for

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redemption to Von Kohorn's operator of a service that can redeem incentives. One would have been motivated to do this in order to allow Von Kohorn's users convenient incentive redemption.

Von Kohorn further discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn further discloses the utilization of networks for disseminating information (Fig. 7; col 38, line 60-col 39, line 5), that coupons can be transmitted to users (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11; col 47, line 40-col 48, line 2; col 2, lines 45-52), and that coupons can be printed (col 10, lines 15-21).

Von Kohorn does not explicitly disclose that the communication channel can be the Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6) and that the coupons can be printed (col 8, lines 59-61).

Saigh further discloses that the service system is associated with an Internet web site (col 14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

Additionally, the Microsoft Press Computer Dictionary Third Edition defines 'personal computer' as,

"A computer designed for use by one person at a time. Personal computers do not need to share the processing, disk, and printer resources of another computer."

Von Kohorn discloses the utilization of a personal computer by the potential customer (Fig. 26; col 75, lines 31-49; col 76, lines 20-33; col 14, lines 20-25).

Von Kohorn further discloses downloading coupon information from a host to a client (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11) where the host is a host computer (col 94, lines 32-47) and the client is a client computer (Fig. 26).

Von Kohorn further discloses the utilization of a personal computer by the potential customer (Fig. 26; col 75, lines 31-49; col 76, lines 20-33).

Von Kohorn further discloses that the consumer can indicate an interest in a product and that incentives can be sent to a consumer in response to the consumer interest (col 47, line 40-col 48, line 2) and that the incentives can be coupons (col 2, lines 45-52).

Von Kohorn does not explicitly disclose that the coupon information on the client is electronically transferred to the central server system.

However, Von Kohorn further discloses recording at the client coupons that are on the client system (col 106, lines 42-48) and utilizing that information in marketing analysis (col 106, lines 48-54; col 108, lines 32-54).

Von Kohorn further discloses two way communication between the client system and the central facility or server system (col 44, lines 27-34; col 69, lines 40-46; col 97, lines 13-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn's two way communication between the client and server system to Von Kohorn's server system utilizing client system information for marketing

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analysis. One would have been motivated to do this in order to provide access to relevant information that can be used for marketing analysis.

Additionally, Von Kohorn discloses tracking and monitoring the pattern of providing and redeeming coupons related to users and time (col 106, line 38-55; col 100, line 54-60; col 101, lines 55-65).

Von Kohorn further discloses displaying products on a client system that feature coupons (col 82, lines 44-54).

Von Kohorn further discloses that coupons feature relevant coupon information (col 82, lines 34-40).

Von Kohorn further discloses that the relevant information on a coupon at the client system can be changed (col 83, lines 15-34).

It is implied that in order to change the coupon information on the client system, the presence of the coupon on the client system must be detected. The system must be able to detect the coupon in order to change the coupon.

Therefore, Von Kohorn discloses detecting the electronic coupon stored on the client system.

Claim 48, 59: Von Kohorn and Saigh disclose a system according to claim 47, 57, Von Kohorn further discloses:

a third server system connected to said communications channel, said third server system being adapted for communicating with said second server system and for authorizing the redemption of said electronic coupon (col 8, lines 47-49; col 82, lines 40-45; col 87, lines 55-66; col 40, lines 10-15).

Claim 49: Von Kohorn and Saigh disclose a system according to claim 47, and Von Kohorn further discloses that said second server system is adapted to redeem said coupon as a function of a transaction initiated between said client system and said second server system (col 8, lines 47-49; col 82, lines 40-45; col 87, lines 55-66; col 40, lines 10-15).

Claim 50: Von Kohorn and Saigh disclose a system according to claim 47, and Von Kohorn further discloses that said second server system is adapted to redeem said coupon by modifying a transaction initiated between said client system and said second server system (col 8, lines 47-49; col 82, lines 40-45; col 87, lines 55-66; col 40, lines 10-15).

Claim 51: Von Kohorn and Saigh disclose a system according to claim 47, and Von Kohorn further discloses that said communications channel includes a network (col 38, line 60-col 39, line 11).

Claim 54: Von Kohorn and Saigh disclose a system according to claim 47, and Von Kohorn further discloses that said electronic coupon is a token issued under the authority of an issuer for the benefit of said client (col 2, lines 49-53).

Claim 55: Von Kohorn and Saigh disclose the system according to claim 47, and Von Kohorn further discloses that said electronic coupon includes data representative of one or more of a serial or identification number, a validation key, an authentication key, an authorizing vendor, a redeeming vendor, a benefit or discount to be associated with a transaction, a level of access granted, and an issuing activity (col 82, lines 34-55).

Claim 56: Von Kohorn and Saigh disclose the system according to claim 47, and Von Kohorn further discloses that said electronic coupon includes data representative of the identity of a location at which additional coupon information resides (col 82, lines 34-55).

Claim 58: Von Kohorn and Saigh disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Von Kohorn further discloses that prior to step A, the server receives a request for information from the client (col 2, line 65-col 3, line 2; Fig. 34; Fig. 22; col 5, lines 31-40).

Claim 60: Von Kohorn and Saigh disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Von Kohorn further discloses the steps of establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon (col 88, lines 32-37).

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Response to Arguments

1. Applicant's arguments with respect to claims 47-62 have been considered but are not found persuasive.

Applicant's arguments with respect to claims 63 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

In regards to Applicant's arguments in the Amendment dated 4/6/04 concerning the U.S.C. 103 rejection utilizing Nichtberger, Valencia, and Cameron,

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...

In regards to the combination of Nichtberger and Valencia,

...

In response to applicant's argument that Von Kohorn is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Von Kohorn discloses the utilization of networks for disseminating information (Fig. 7; col 38, line 60-col 39, line 5), that coupons can be transmitted to users (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11; col 47, line 40-col 48, line 2; col 2, lines 45-52), and that coupons can be printed (col 10, lines 15-21).

On page 11 of the Applicant's Amendment dated 4/6/04, Applicant states, "There appears to be not teaching, suggestion, or motivation to modify Von Kohorn to enable electronic redemption."

However, Von Kohorn explicitly discloses electronic redemption (col 40, lines 10-15).

Von Kohorn does not explicitly disclose that the electronic coupon is electronically redeemed by the central station.

However, Von Kohorn further discloses electronic communication and electronic communication between a client and server system (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15; col 88, lines 29-55).

Von Kohorn further discloses redeeming incentives and mailing incentives for redemption (col 8, lines 47-49), redeeming incentives in a variety of manners including over the phone (col 82, lines 40-45; col 87, lines 55-66).

Von Kohorn further discloses that the operator of the service can redeem incentives (col 71, lines 17-23).

Von Kohorn further discloses that tokens can be coupons (col 2, lines 48-53; col 8, lines 44-49).

Von Kohorn further discloses that the first server system and second server system can be part of the same server system (Fig. 31; col 89, lines 37-42).

Von Kohorn further discloses the electronic transfer of incentive information to redemption centers for redemption (col 40, lines 10-15).

Hence, Von Kohorn discloses that either a second, different server system or a second server system associated with the first server system can electronically redeem incentives.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information for redemption to Von Kohorn's operator of a service that can redeem incentives. One would have been motivated to do this in order to allow Von Kohorn's users convenient incentive redemption.

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On page 12 of the Applicant's Amendment dated 4/6/04, Applicant states, "... does not appear to disclose, teach, or suggest the features of a second (or subsequent) server detecting the electronic coupon stored on the client system."

Von Kohorn does not explicitly disclose that the coupon information on the client is electronically transferred to the central server system.

However, Von Kohorn further discloses recording at the client coupons that are on the client system (col 106, lines 42-48) and utilizing that information in marketing analysis (col 106, lines 48-54; col 108, lines 32-54).

Von Kohorn further discloses two way communication between the client system and the central facility or server system (col 44, lines 27-34; col 69, lines 40-46; col 97, lines 13-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn's two way communication between the client and server system to Von Kohorn's server system utilizing client system information for marketing analysis. One would have been motivated to do this in order to provide access to relevant information that can be used for marketing analysis.

Additionally, Von Kohorn discloses tracking and monitoring the pattern of providing and redeeming coupons related to users and time (col 106, line 38-55; col 100, line 54-60; col 101, lines 55-65).

Von Kohorn further discloses displaying products on a client system that feature coupons (col 82, lines 44-54).

Von Kohorn further discloses that coupons feature relevant coupon information (col 82, lines 34-40).

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Von Kohorn further discloses that the relevant information on a coupon at the client system can be changed (col 83, lines 15-34).

It is implied that in order to change the coupon information on the client system, the presence of the coupon on the client system must be detected. The system must be able to detect the coupon in order to change the coupon.

Therefore, Von Kohorn discloses detecting the electronic coupon stored on the client system.

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(10) Response to Argument

VII. A.

The following is in response to the Appellant's arguments presented in section VII. A. beginning on page 8 of the Appellant's Appeal Brief dated 4/13/2005 that address the 35 USC 112 rejections.

Examiner notes that in Appellant's attempt to provoke an Interference, Appellant has copied the claims of US Patent 6,076,069 to Laor. It is because the Appellant's has copied

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claims from a different US Patent that the Appellant does not find adequate support for some features in the Appellant's own Specification.

1. Beginning page 9, the Appellant presents arguments concerning Claim 52. Claim 52 discloses a TCP/IP network. However, nowhere in applicants specification is a TCP/IP network explicitly disclosed. Examiner notes that the claim is broader in scope than the specification. A TCP/IP network is broader than the Internet. Because TCP/IP is a protocol, there are TCP/IP based networks which are not part of the Internet. Hence, a TCP/IP network is broader than the Internet which is one manifestation of a TCP/IP network. Applicant can not claim something broader than what is supported in the Specification. A TCP/IP network is broader than the Internet. Therefore, the Applicant's Specification supports the utilization of the Internet but not of a TCP/IP network. See MPEP 2163.05 Changes to the Scope of Claims and I. Broadening Claim.

2. Beginning on page 10, the Appellant presents arguments concerning Claim 58. Claim 58 discloses, 'according to claim 57 wherein prior to step A, the server receives a request for information from the client'. However, the Applicant's Specification does not disclose the server receiving a request for information from the client prior to establishing a connection over a communications channel between a client and a server.

VII. B.

The following is in response to the Appellant's arguments presented in section VII. B. beginning on page 11 of the Appellant's Appeal Brief dated 4/13/2005 that address the 35 USC 103(a) rejections.

1. Beginning on page 12, Appellant states that independent claim 47 and dependent claims 48-51 and 53-56 are patentable under 35 USC 103(a) over Nichtberger in view of Valencia.

a. On page 12, the Appellant states that, "The Examiner's interpretation of 'client system' is strained and inconsistent with the meaning given to the term by those of ordinary skill in the art."

Examiner notes that the word 'client' nor any of its derivatives appears anywhere in the Appellant's Specification. Hence, the term 'client' in the Appellant's claims can be open to a broad interpretation.

Also, Examiner notes that in Appellant's attempt to provoke an Interference, Appellant has copied the claims of US Patent 6,076,069 to Laor. It is because the Appellant's has copied claims from a different US Patent that the Appellant's disclosure happens to not make any mention of a 'client' at all.

Also, the online Merriam-Webster dictionary at www.m-w.com defines 'client' as:
"b : **CUSTOMER** <hotel *clients*> c : a person served by or utilizing the services of a social agency <a welfare *client*> d : a computer in a network that uses the services (as access to files or shared peripherals) provided by a server".

Hence, the 'client system' in the Appellant's claims was interpreted by the Examiner to be the user system or the customer system. Also, the client system of Nichtberger and Valencia is a client/user/customer computer that connects to the network of Nichtberger and Valencia which is utilized for coupon utilization and processing.

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Also, Examiner notes that it is the Appellant's claims as stated in the Appellant's claims that are being rejected with the prior art. Hence, in claims 47 and 57-51, the Appellant states, 'said client system including a computer processor and associated memory'. Whether the client system is a Personal Digital Assistant, personal computer, mainframe, laptop, or other form of client system is irrelevant as the Appellant's claims make no statement as to the type of client system. The claims do state that the client system must have a computer processor and associated memory. And, the Valencia reference clearly discloses a client system, in the form of a smart card, with a computer processor associated memory. Additionally, the Appellant's amendment dated 4/6/04 on page 11 states that a Smart Card, 'contains electronic memory. . . an embedded integrated circuit. . . storing. . . records. . . generating network Ids'. Hence, the specification of Valencia discloses the features of the Appellant's client system as stated in the Appellant's claims.

b. On page 14, the Appellant states that, "There is not teaching, suggestion, or motivation to combine Nichtberger and Valencia.

However, Nichtberger discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

c. On page 15, the Appellant states that, "Assume arguendo that there was a teaching, suggestion, or motivation to combine Nichtberger and Valencia, the rejection would still be improper as the two references, even when combined, fail to teach or suggest all of the claim elements.

1. On page 15, Appellant states that, "Nichtberger/Valencia fail to teach a client system". Please see how the client system is addressed by Nichtberger/Valencia as explained above in Response to Arguments section VII.B.1.a.

2. On page 16, Appellant states that, "Nichtberger/Valencia fail to teach a second server system connected to the same communications channel as the first server system."

However, Nichtberger clearly discloses that there are multiple server systems that interact with the client system for coupon distribution and redemption (Fig. 1, item 10; Col 4, lines 41-47). Hence, the user utilizing the client system can be transmitted coupons at one location by a first server system and redeem coupons at a different location by a second or different server system.

3. On page 17, Appellant states that, "Nichtberger/Valencia fail to teach the first server system being adapted for transmitting an electronic coupon to said client system over said communications channel, and the client system being adapted for storing said electronic coupon in said memory."

However, Nichtberger (col 30, lines 1-6) and Valencia (col 7, lines 41-49) clearly discloses that the client system stores electronic coupon in said memory.

Additionally, in Nichtberger (col 30, lines 1-6) it is implied that the coupon information in the first server system is transmitted to the client system, which is the card. That the coupon information is transmitted is implied because the coupon information is stored electronically on both the first server system and the client system. And, the information is 'recorded' on the second client system. Hence, the information must be transmitted in order to be recorded in a device where the information had not been.

2. Beginning on page 19, Appellant states that Independent claim 57 and dependent claims 58-60 are patentable under 35 USC 103(a) over Nichtberger in view of Valencia.

Please see the Response to Arguments above concerning how the combination of Nichtberger and Valencia renders the features of the Appellant's claims obvious.

3. Beginning on page 20, Appellant states that Dependent claims 48-51, 53-56, and and 58-60 are separately patentable over the combination of Nichtberger and Valencia.

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Appellant states that none of the features of any of the Appellant's dependent claims are disclosed by the prior art combination of Nichtberger and Valencia. Appellant lists the dependent claims and states that it is not disclosed by the combination of Nichtberger and Valencia. However, please see the Response to Arguments section above and the Final Rejection section above for citations and demonstrations as to how the combination of Nichtberger and Valencia render obvious the Appellant's features of the Appellant's dependent claims.

Examiner notes that once a feature is established that that feature is also established for all subsequent claims and depending claims. Hence, the rejection for later features of a claim and subsequent dependent claims build on what has already been demonstrated by the Examiner.

4. Beginning on page 24, Appellant states that Claims 52 and 63 are patentable over the combination of Nichtberger and Valencia, further in view of Cameron.

a. Beginning on page 24, Appellant presents arguments concerning claim 52.

However, Cameron is analogous art to Nichtberger and Valencia. Cameron discloses redeeming coupons over a network that operated over remote areas that utilizes a TCP/IP based network (col 5, lines 13-16; col 11, lines 10-15). Cameron discloses utilizing coupons throughout the Cameron disclosure. Cameron, Nichtberger, and Valencia all disclose features for utilizing coupons. Therefore, Cameron is analogous art to Nichtberger and Valencia.

Please see the above Final Rejection and the above Response to Arguments for citations and explanations as to how Nichtberger and Valencia renders the features of the Appellant's claimed invention obvious.

b. Beginning on page 24, Appellant presents arguments concerning claim 63. Please see the immediately preceding Response to Arguments section VII.B.4.a. concerning claim 52 for the response to arguments concerning this claim 63.

In conclusion, the combination of Nichtberger and Valencia renders obvious the features of the Appellant's claimed invention.

5. Beginning on page 26, Appellant states that Claims 47-63 are patentable over the combination of Von Kohorn in view of Saigh.

a) Beginning on page 26, Appellant states that Von Kohorn and Saigh are nonanalogous art.

Examiner notes that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, the numerous citations made from Von Kohorn demonstrate the relevance of the Von Kohorn specification to the Appellant's claims.

Also, Saigh discloses the providing of information that can include a wide range of content including promotions, advertising, and coupons:

“(26) From network interface 324, server 304 communicates with central transaction data base 104 for electronic filing of transaction reports, communicates with Book Bank 302 to

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give Book Bank 302 downloading instruction orders and to receive the status reports and the inventory reports from Book Bank 302. Server 304 also is coupled, through network interface 324, to a Book Bank subsystem to receive subsystem reports in order to give instructions and orders whenever necessary, as hereinafter discussed. External network systems such as institutional or corporate network systems with local merchants terminals, community bulletin board services and others can also be coupled to the network interface 324. The network interface 324 also allows two-way connecting with interbank networks such as Cirrus, Plus or other similar data transfer network. Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons. Maintenance interface 326 enables remote or on-site diagnosis and repair of server 304 (col 7, line 55-col 8, line 7);

(29)...A buffer memory 360 is utilized to speed up downloading in order to accommodate high volume users during the peak seasons. A printer 362 is provided to print coupons on demand, receipts and various reports for the users. A power supply 364 provides power to printer 362, CPU 350, secondary storage device 358 and local storage 356. An uninterrupted power supply 366 coupled to primary power supply 364 assures continuous operation even during power down time (col 8, lines 56-65);

(54)... The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand, virtual shopping, catalog sales, demos, subscription orders, electronic applications of credit cards, calling cards, or other types of services. Some public domain information distributed such as community events, ticket sales,

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institutional events or even public bulletins could also be distributed with the promotional information as a free or low cost service to the community" (col 14, line 60-col 15, line 4).

Also, Von Kohorn discloses the utilization of networks for disseminating information (Fig. 7; col 38, line 60-col 39, line 5), that coupons can be transmitted to users (col 74, lines 33-55; Fig. 29; col 2, lines 45-57; col 5, lines 56-61; col 22, lines 1-11; col 47, line 40-col 48, line 2; col 2, lines 45-52), and that coupons can be printed (col 10, lines 15-21).

Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6) and that the coupons can be printed (col 8, lines 59-61).

Hence, both Von Kohorn and Saigh provide information and content to the user that can include promotions, advertising, and coupons. Therefore, Von Kohorn and Saigh are analogous art relevant to the Appellant's claims.

b) Beginning on page 30, Appellant states that Von Kohorn and Saigh, even when combined, fail to disclose teach or suggest all of the elements of claims 47-63.

On page 32, Appellant states, "Appellants first note that Von Kohorn, at col. 87, lines 55-66, does not appear to teach the claim element of a second (or subsequent) server being adapted to redeem an electronic coupon. Rather, this passage recites that a shopper transmits a coupon to a redemption center by mail, by telephone, or in person. Moreover, there appears to be no teaching, suggestion, or motivation to modify Von Kohorn to enable electronic redemption."

Von Kohorn explicitly discloses redemption information transferred electronically:

“(176) Sweepstakes symbols determined at a central location may be provided electronically or otherwise to redemption centers, together, when required, with a formula for identifying an acceptable correlation with symbols on a winning coupon, thus identifying such a coupon as one qualifying for sweepstakes prize” (col 40, lines 10-15).

Von Kohorn does not explicitly disclose that the electronic coupon is electronically redeemed by the central station.

However, Von Kohorn further discloses electronic communication and electronic communication between a client and server system (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15; col 88, lines 29-55).

Von Kohorn further discloses redeeming incentives and mailing incentives for redemption (col 8, lines 47-49), redeeming incentives in a variety of manners including over the phone (col 82, lines 40-45; col 87, lines 55-66).

Von Kohorn further discloses that the operator of the service can redeem incentives (col 71, lines 17-23).

Von Kohorn further discloses that tokens can be coupons (col 2, lines 48-53; col 8, lines 44-49).

Von Kohorn further discloses that the first server system and second server system can be part of the same server system (Fig. 31; col 89, lines 37-42).

Von Kohorn further discloses the electronic transfer of incentive information to redemption centers for redemption (col 40, lines 10-15).

Hence, Von Kohorn discloses that either a second, different server system or a second server system associated with the first server system can electronically redeem incentives.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information for redemption to Von Kohorn's operator of a service that can redeem incentives. One would have been motivated to do this in order to allow Von Kohorn's users convenient incentive redemption.

On page 32, Appellant states, "Neither this statement, nor the passages in Von Kohorn cited by the Examiner, however, appear to address the claim element of a second (or subsequent) server detecting the electronic coupon stored on the client system."

Note that the Appellant's claims allow the second server to be a subsequent server. Hence, the second or subsequent server that does the detecting need not be a different server.

Also, Von Kohorn does not explicitly disclose that the coupon information on the client is electronically transferred to the central server system.

However, Von Kohorn further discloses recording at the client coupons that are on the client system (col 106, lines 42-48) and utilizing that information in marketing analysis (col 106, lines 48-54; col 108, lines 32-54).

Von Kohorn further discloses two way communication between the client system and the central facility or server system (col 44, lines 27-34; col 69, lines 40-46; col 97, lines 13-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn's two way communication between the client and server system to Von Kohorn's server system utilizing client system information for marketing analysis. One would have been motivated to do this in order to provide access to relevant information that can be used for marketing analysis.

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Additionally, Von Kohorn discloses tracking and monitoring the pattern of providing and redeeming coupons related to users and time (col 106, line 38-55; col 100, line 54-60; col 101, lines 55-65).

Von Kohorn further discloses displaying products on a client system that feature coupons (col 82, lines 44-54).

Von Kohorn further discloses that coupons feature relevant coupon information (col 82, lines 34-40).

Von Kohorn further discloses that the relevant information on a coupon at the client system can be changed (col 83, lines 15-34).

It is implied that in order to change the coupon information on the client system, the presence of the coupon on the client system must be detected. The system must be able to detect the coupon in order to change the coupon.

Therefore, Von Kohorn discloses detecting the electronic coupon stored on the client system.

Beginning on page 33, Appellant states that there is no motivation to combine Von Kohorn and Saigh. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Also, the test for obviousness is not whether the features of a

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secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner further notes that Von Kohorn discloses utilizing a home computer in communication with other computers by way of networks utilizing cable connections or telephone connections:

“(209) ...interested viewers who are potential buyers have the opportunity to request additional or supplemental information over cable connections such as cable or telephone connections used for home computers” (col 47, lines 40-45).

Examiner further notes that as both Von Kohorn and Saigh provide information and content to the user that can include promotions, advertising, and coupons, Saigh was added to Von Kohorn to provide Von Kohorn with further communication network capabilities via the Internet. Von Kohorn would be motivated to utilize the Internet to take better advantage of a network that is far reaching and readily available.

Therefore, there is motivation to combine Von Kohorn and Saigh.

c) Beginning on page 34, Appellant states Dependent Claims 48-46 and 58-60 are patentable over VonKohorn in view of Saigh.

Appellant states that none of the features of any of the Appellant's dependent claims are disclosed by the prior art combination of Von Kohorn and Saigh. Appellant lists every dependent claim and states that it is not disclosed by the combination of Von Kohorn and Saigh.

However, please see the Response to Arguments section above and the Final Rejection section above for citations and demonstrations as to how the combination of Von Kohorn and Saigh render obvious the Appellant's features of the Appellant's dependent claims.

Also, Examiner notes that a 35 USC 103(a) rejection was made and that it is the features of Von Kohorn and of Saigh and the combination of features of Von Kohorn and Saigh that render the Appellant's claimed invention obvious.

Examiner notes that once a feature is established that that feature is also established for all subsequent claims and depending claims. For example, once Von Kohorn and Saigh have been utilized to demonstrate the obviousness of utilizing the Internet for communication purposes, the same demonstration of the obviousness of utilizing the Internet is not represented. Rather, subsequent features and dependent claims would presuppose that the utilization of the Internet was demonstrated earlier in rejection and not represent the Internet utilization demonstration. Note that the demonstration of the combination of Von Kohorn and Saigh such that it would be obvious that Von Kohorn can utilize the Internet for communication purposes was made in the above sections.

Hence, the rejection for later features of a claim and subsequent dependent claims build on what has already been demonstrated by the Examiner.

In conclusion, the combination of Von Kohorn and Saigh renders obvious the features of the Appellant's claimed invention.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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